

## **REMARKS**

The Examiner is thanked for the thorough examination of this application. The Office Action, however, continued to reject all pending claims. The Office Action also objected to claims 1 and 16 for certain informalities. Regarding the rejections, the Office Action rejected claims 1, 3, 7-8, 16-17 and 21-22 under 35 U.S.C. § 112, first paragraph, and further rejected claim 21 under 35 U.S.C. § 112, second paragraph for being dependant on a cancelled claim. The Office Action also rejected claims 1, 3, 7-8, 16-17, and 21-22 under 35 U.S.C. § 103(a) as allegedly unpatentable over Mowery et al. (US Patent 6,984,152) in view of Jones et al (US Patent No. 6,438,638). Applicant has amended the specification and claims herein in such a way that renders the various objections and rejections moot. Notwithstanding, Applicant sets for the following additional distinguishing remarks.

For at least the reasons set forth hereinafter, Applicant respectfully requests reconsideration and withdrawal of the rejections.

## **I. Discussion of Objections**

In response to the objection to claims 1, 3, 7-8, 16-17 and 21-22, Applicant has changed the term “two system-end interfaces” back to the original term “double-configuration connector interface” but will appreciate the Examiner’s understanding that the double-configuration connector interface is construed to have two different kinds of system-end interfaces, one being universal serial bus and the other being PCI Express, for the same reasons in the previous responses and for the sake of consistency with what is referred to in pending claims. The CONN1 in FIG. 4 and FIG. 7, which interfaces an ExpressCard to the adapter of the claimed embodiments, and an CONN2 in FIG. 4 and FIG. 7, which interfaces USB to the adapter of the claimed embodiments.

The terminology of “storage media” in the claimed embodiments refers not only to CF cards, but also to other small storage cards such as MS, SD/MMC, SM or xD, as recited in paragraphs [0006], [0007], and [0010] of the specification. Therefore, in order to clarify the generic terminology in a consistent manner, “storage media/medium”, “CF storage media/medium”, “CompactFlash storage media/medium” and “Compact Flash format storage media/medium” are heretofore presented as “CompactFlash format storage media/medium,” as recited in paragraph [0023], which has an electrical features complying with the standard CompactFlash specification.

Applicant has also added further limitations in the claims. Since all the limitations added by these amendments are fully supported by the as-filed specification and drawings, no new matter is added to the application and withdrawal of the objections is respectfully requested.

In short, claims 1, 3, 7-8, 16-17 and 21-22 were objected to because of noted informalities. Applicant has amended the claims according to Examiner's suggestion to overcome the objections. Accordingly, withdrawal of the objections is respectfully requested.

## **II. Discussion of Rejections of Claims 1, 3, 7-8, 16-17 and 21-22 Under 35 § USC 112**

Claims 1, 3, 7-8, 16-17 and 21-22 stand ejected under 35 USC §112, second paragraph. Applicants respectfully request reconsideration and withdrawal of the rejection for at least the following reasons.

The double-configuration connector interface includes a PCI Express interface and a USB interface, which are supported by FIG. 4 and FIG. 7 and paragraph [0009] of the present application. As amended, claim 1 defines (among other distinguishing features): "...a double-configuration interface, having two different system-end formats, wherein the system-end formats include an universal serial bus interface and a PCI Express interface...", which the universal serial bus interface and the PCI Express interface have a respective physical port connected to the corresponding system ends.

The term "storage media" in pending claims refers to not only CF cards, but also other small storage cards such as MS, SD/MMC, SM or xD, as recited in paragraphs [0006], [0007], and [0010]. From paragraph [0006] of the specification, it is clear that there are some sockets of different sizes matching different storage media. CF card is exemplified in the embodiments while the architectures interfacing other kinds of storage media to the adapter are well known and therefore is not necessary to such in details. As amended, claim 1 reads: "... a storage media interface, connected one of

different kinds of CompactFlash-format storage media to the multiple format interface adapter...”, in which the connection of storage media to the adapter is clearly NOT simultaneous.

Furthermore, all claims have been further amended to provide clear and proper antecedent basis for all terms, in accordance with the Examiner’s suggestions.

### **III. Discussion of Rejection of Claims 1, 3-4, 8, 20 and 21 under 35 U.S.C. § 103(a)**

Claims 1, 3, 7-8, 16-17 and 21-22 stand rejected under 35 U.S.C. § 103(a) as allegedly anticipated by Mowery et al in view of Jones et al. Applicants respectfully request reconsideration and withdrawal of this rejection, in view of the amended claim language of independent claim 1.

As amended, independent claim 1 recites:

1. A multiple format interface adapter for small storage media, comprising:
  - a storage media interface, connected one of different kinds of CompactFlash-format storage media to the multiple format interface adapter;
  - a double-configuration interface, **having two different system-end formats, wherein the system-end formats include an universal serial bus interface and a PCI Express interface** to electrically connect the multiple format interface adapter to any one of two different kinds of system ends; and
  - a signal controller, converting signals between the double-configuration interface and the storage media interface when one of the CompactFlash-interface storage media inserts in the multiple format interface adapter.

*(Emphasis added.)* Claim 1 patently defines over the cited art for at least the reason that the cited art fails to disclose the features emphasized above.

In contrast to the claimed embodiments, Mowery discloses a passive socket having a plurality of media card connectors, and a host connector connected to the

media card connectors and ONE connector of the host computer, wherein the connector of the host computer conforms to a PCMCIA standard. Significantly, however, Mowery fails to teach or suggest claimed features of a double-configuration interface **having two different system-end formats, wherein the system-end formats include an universal serial bus interface and a PCI Express interface** to electrically connect the multiple format interface adapter to any one of two different kinds of system ends, as expressly recited in amended claim 1 (and clearly supported by FIG. 4 and FIG. 7 and paragraph [0009] of the specification). For at least this reason, the rejection of claim 1 should be withdrawn.

The Examiner has relied on an interface adaptor (Fig. 3, ref. 40) card reader that connects one of a plurality of memory cards (Fig. 3B, ref. 41, 43, 45, 47) of different formats to a plurality of system-end interfaces (Fig. 3B, ref. 51, 53 and Fig. 4, ref. 176) to cure the deficiency of Mowery. Applicant respectfully submits that the system-end interfaces indicated by reference numerals 51 and 53, which respectively represent a IDE interface and a PCMCIA interface, have been misconstrued as the different system-end formats of the claimed embodiments, because the system-end formats of the claimed embodiments include an universal serial bus interface and a PCI Express interface, which are known to have different physical and electric specifications from the IDE interface and the PCMCIA interface. Accordingly, the rejection of claim 1 should be withdrawn.

As a separate and independent basis for the patentability of independent claim 1, Applicants respectfully submit that there is no proper basis for selectively combining teachings from Mowery and Jones in the manner alleged by the Office Action (i.e., “for

the benefit of increasing the number of types of memory card that can be read by the multiple format interface adapter properly and also implementing an active adapter, which can be used interchangeably connecting a different memory/memories of a device”).

It is well settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

When an obviousness determination is based on multiple prior art references, there must be a showing of some “teaching, suggestion, or reason” to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

In this regard, the MPEP section 2141 states:

Office policy has consistently been to follow Graham v. John Deere Co. in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquires enunciated

therein as a background for determining obviousness are briefly as follows:

- (A) Determining of the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

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#### BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Simply stated, the Office Action has failed to at least (1) ascertain the differences between and prior art and the claims in issue; and (2) resolve the level of ordinary skill in the art. Furthermore, the alleged rationale for combining the two references (i.e., “for the benefit of implementing an active adapter that can be used interchangeably connecting a different memory/memories and a device” – Office Action, p. 8) embodies clear and improper hindsight rationale.

Simply stated, the rationale relied upon by the Office Action is clearly inconsistent with well established precedent and warrants a withdrawal of the rejections.

## CONCLUSION

For at least the foregoing reasons, it is believed that all of the pending claims 1, 3, 7-8, 16-17, and 21-22 of the present application patently define over the prior art and are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

If Examiner has any questions regarding this filing or the application in general, Examiner is invited to contact the undersigned at 770-933-9500.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

/Daniel R. McClure/

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